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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/464,348	12/15/1999	MILAN M. SHAH	13768.122	7423

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EXAMINER

BURGESS, BARBARA N

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 12/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/464,348

Applicant(s)

SHAH ET AL.

Examiner

Barbara N Burgess

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,9-12 and 33-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 9-12, 33-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This Office Action is a response to Request for Continuation Examination (RCE) filed October 19, 2004. Claims 1, 9-12, 33-45 are presented for further examination, while claims 46-47 are presented for initial examination.

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 9-12, and 33-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thurlow et al. (hereinafter "Thurlow", 5,917,489) in view of Gainey et al. (hereinafter "Gainey", US 2002/0099681 A1).

As per claims 1 and 12, Thurlow discloses in a messaging system used for exchanging information, the system utilizing standard Internet protocol, a method and computer-readable medium having computer-executable instructions for extending the protocol to allow for the ability to customize messaging operations performed on an electronic message without deviating from the protocol specification, the method and computer-readable medium having computer-executable instructions comprising the steps of:

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- Storing a standard command, wherein the standard command is based on a standard Internet protocol, the standard command having an assigned priority (column 8, lines 6-10, 41-46, column 9, lines 55-61);
- Storing a user-created command, wherein the user-created command is based on extensions of the standard Internet protocol, and wherein the standard command and the user-created command are used for manipulating the message (column 9, lines 15-25, column 10, lines 39-50, column 11, lines 40-46).

Thurlow does not explicitly disclose:

- Assigning a user-defined priority to the user-created command relative to an assigned priority of the standard command, wherein assigning any user-defined priority to the user-created command lower than the assigned priority of the standard command causes the standard command to be executed with the user-created command, such that the user-created command augments the standard command, and wherein assigning any user-defined priority to the user-created command higher than the assigned priority causes the user-created command to bypass the standard command, and such that the user-created command is executed without the standard command being executed;
- Executing at least one of the standard command and the user-created command according to the assigned priority.

However, in an analogous art, Gainey discloses assigning priority to the rules used to manipulate the messages as well as executing the rules based on their individual priority (paragraphs [0033] – [0051]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Gainey's assigning priority to the commands in Thurlow's method making the rules effective in such a manner that no rule actions conflict with each other.

As per claims 9 and 43, Thurlow discloses the method and computer-readable medium having computer-executable instructions as recited in claims 1 and 12 wherein the standard command is stored in a first database (column 8, lines 41-46, column 10, lines 41-47, column 14, lines 50-54);

As per claims 10 and 44, Thurlow discloses the method and computer-readable medium having computer-executable instructions as recited in claims 9 and 20, wherein the user-defined command is stored in a second database (column 8, lines 41-46, column 10, lines 41-47, column 14, lines 50-54);

As per claims 11 and 45, Thurlow discloses the method and computer-readable medium having computer-executable instructions as recited in claims 10 and 20, wherein the first database and the second database are the same database (column 8, lines 41-46, column 10, lines 41-47, column 14, lines 50-54).

As per claims 33 and 38, Thurlow further discloses the method and computer-readable medium having computer-executable instructions as recited in claims 1 and 12

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including an act of identifying the at least one of the standard command and the user-created command that is to be executed based upon a determination of whether the user-created command is registered in an event-binding database (column 10, lines 40-45, column 12, lines 57-67column 17, lines 1-25).

As per claims 34 and 39, Thurlow discloses the method and computer-readable medium having computer-executable instructions as recited in claims 33 and 38 including an act of registering the user-created command into an event-binding database and prior to executing the user-created command an act of determining that the user-created command is registered in the event-binding database (column 9-13).

As per claims 35 and 40, Thurlow discloses the method and computer-readable medium having computer-executable instructions as recited in claims 1 and 12. Thurlow does not explicitly disclose the priority of the standard command is a neutral priority.

However, in an analogous art, Gainey discloses assigning priority to the rules used to manipulate the messages as well as executing the rules based on their individual priority (paragraphs [0033] – [0051]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Gainey's assigning neutral priority to the commands as well as a priority other than neutral in Thurlow's method making the rules effective in such a manner that no rule actions conflict with each other.

As per claims 36 and 41, Thurlow discloses the method and computer-readable medium having computer-executable instructions as recited in claims 35 and 40.

Thurlow does not explicitly disclose the assigned priority of the user-created command is a priority other than a neutral priority.

However, in an analogous art, Gainey discloses assigning priority to the rules used to manipulate the messages as well as executing the rules based on their individual priority (paragraphs [0033] – [0051]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Gainey's assigning neutral priority to the commands as well as a priority other than neutral in Thurlow's method making the rules effective in such a manner that no rule actions conflict with each other.

As per claims 37 and 42, Thurlow discloses the method and computer-readable medium having computer-executable instructions as recited in claims 36 and 41.

Thurlow does not explicitly disclose:

- An act of sorting at least the user-created command and the standard command in a database based upon their priority prior to executing the at least one of the standard command and the user-created command.

However, in an analogous art, Gainey discloses a rule list in which action priority is determined by the rule's order (paragraph [0043]-[0045]).

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Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Gainey's sorting the commands based on priority in Thurlow's method in order to determine the order of the rules and which rule(s) has the highest priority.

As per claims 46 and 47, Thurlow discloses a method and computer program product as recited in claims 1 and 12

Thurlow does not explicitly disclose modifying one of the assigned priorities. However, in an analogous art, Gainey discloses assigning priority to the rules used to manipulate the messages as well as executing the rules based on their individual priority (paragraphs [0033] – [0051]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate Gainey's assigning priority to the commands in Thurlow's method making the rules effective in such a manner that no rule actions conflict with each other.

### ***Response to Arguments***

**The Office notes the following arguments:**

(a) Gainey fails to teach that the commands are executed in order of assigned priority.

3. Applicant's argument filed has been fully considered but is not persuasive.

**In response to:**

(a) Gainey discloses the email receiver making sure that no routing rule actions conflict with each other. In order to avoid conflicts, priorities are placed on rule actions. Gainey does disclose priority being determined based on the rule's order in the rule list; however, some rules take priority over order. For example, an internal collaborate action takes precedence over all other actions. As well, drop action takes precedence over all other actions except collaborate. Therefore, priority to a user-created command is relative to the priority of standard commands (paragraphs [0034-0051]). Gainey further teaches user-created commands and standard commands stored in a list in the category database. In order for a rule (user-created command) to be implemented, it must be stored in a category. Therefore, once it is stored, it then receives a priority, and then it can be implemented or executed by the email receiver (paragraphs [0052-0063, 0069]). So, Gainey teaches that the commands are executed in order of assigned priority.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara N Burgess whose telephone number is (571) 272-3996. The examiner can normally be reached on M-F (8:00am-4:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone numbers

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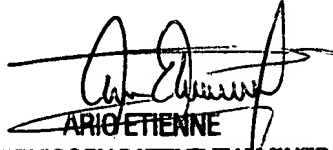
for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Barbara N Burgess  
Examiner  
Art Unit 2157

\*\*\*

December 3, 2004

  
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